

#13 Follow
Supple Response
PATENT

I hereby certify that on the date specified below, this correspondence is being forwarded by facsimile transmission to the United States Patent and Trademark Office, at fax number 703-308-4242, to the attention of Examiner Gupta of Art Unit 1654.

February 18, 2000
Date

Susan C. Clingerman
Susan C. Clingerman

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael T. Kelly, Raymond J. Andersen and Jeff Gerard
Application No. : 09/043,813
Filed : September 29, 1998
For : CYCLIC DECAPEPTIDE ANTIBIOTICS

Examiner : Anish Gupta
Art Unit : 1654
Docket No. : 850103.40301
Date : February 18, 2000

Assistant Commissioner for Patents
Washington, DC 20231

SUPPLEMENTAL RESPONSE

Claims 1-6 are presently pending in the Office Action. No claims have been canceled, added or amended.

In response to the Office Action dated June 9, 1999, Applicants filed a Response on December 9, 1999. That Response (incorrectly titled "Amendment") acknowledged that claims 1-4 stood provisionally rejected as being unpatentable over claim 54 of co-pending application number 08/751,300, now U.S. Patent 5,962,407, under the judicially-created doctrine of obviousness-type double patenting. That Response also indicated that Applicants did not

agree with the rejection. That Response further indicated that an executed Terminal Disclaimer would be submitted in order to obviate the rejection.

At the present time, Applicants submit the following argument to explain why the obviousness-type double patent rejection was improperly applied to pending claims 1-4. This argument is submitted in lieu of submitting a Terminal Disclaimer. Applicants request that the Examiner reconsider and withdraw the obviousness-type double patenting rejection in view of the following argument.

The Office Action supports the obviousness-type double patenting rejection by stating that the co-pending (now issued, see U.S. Patent 5,962,407) claim 54 is drawn to a pharmaceutical formulation whereas the claims 1-4 of the instant application are drawn to the compound. The Office Action concludes that such a variant is obvious because in producing the desired pharmaceutical formulations one would have to necessarily have the isolated compounds. The rejection is traversed for the following reasons.

The pending claims are directed to certain isolated compounds. However, the pharmaceutical formulations of the issued patent do not recite, or necessarily encompass, the isolated compounds of those pending claims. Thus, while the pending claims are directed to three specific peptides, the pharmaceutical formulations are directed to compositions that include various derivatives of the isolated compounds, *not the compounds themselves*. Accordingly, one would not necessarily need to have the isolated compounds in order to produce the pharmaceutical formulations. One could, for instance, prepare a derivative of a compound according to the synthetic methodology disclosed in, for example, Example A4 (col. 14, lines 26 to col. 16, line 39) of the issued patent, and then formulate that derivative into a pharmaceutical composition, while never generating or handling the "isolated compound" *per se*. Likewise, one could prepare salts of the derivatives, and then "derivatize" the salt in order to form a salt of the isolated compound that could be formulated into a pharmaceutical composition. Accordingly, it is definitely not the case that in order to produce the claimed pharmaceutical formulations, one would have to necessarily have the isolated compounds.

To summarize, the chemical species recited as being present in the pharmaceutical formulations (claim 54 of the issued patent) are not the same chemical species that are the subject

of the pending claims (1-4). Accordingly, one would not need the chemical species of pending claims 1-4 in order to prepare the pharmaceutical compositions of the issued patent.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

If any issue requires further discussion, the Examiner is encouraged to contact the undersigned to resolve the matter, at 206-622-4900.

Respectfully submitted,

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC



David W. Parker
Registration No. 37,414

DWP:scc

Enclosure:

Facsimile Transmission sheet
Form PTO-1083

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
(206) 622-4900
Fax: (206) 682-6031

dwp\7512

SEED

Intellectual Property Law Group PLLC

OFFICIAL
FAX RECEIVED701 Fifth Avenue, Suite 6300
Seattle WA 98104-7092 USA
Facsimile: (206) 682-6031
Telephone: (206) 622-4900
www.seedlaw.com

February 18, 2000

FEB 22 2000

David W. Park, Ph.D.
davidp@seedlaw.com

GROUP 1600

Facsimile Transmission5 pages (including this page)TO: U.S. Patent and Trademark Office
Fax No.: 1-703-308-4242RE: Application serial no.: 09/043,813
Art unit: 1654
Filing date of application: September 29, 1998
Examiner assigned to application: Anish Gupta
Title of the invention: Cyclic Decapeptide Antibiotics
Attorney docket number: 850103.40301

FAX RECEIVED

FEB 22 2000

GROUP 1600

☐ Urgent ☐ For Review ☐ Please Confirm Receipt ☐ Please Reply ASAP

Comments:

If you do not receive all pages, please call Susan Clingerman at (206) 622-4900 or fax our office.

Transmission Information: Date _____ Time _____ By _____

CONFIDENTIALITY NOTICE: The information contained in this facsimile message is legally privileged and/or confidential information intended only for the use of the individual or entity named below. If you are not the intended recipient, you are hereby notified that any use, dissemination, distribution, or copying of this facsimile or its content is strictly prohibited. If you have received this facsimile in error, please immediately notify us by telephone and return the original facsimile message to us by mail or destroy it without making a copy. Thank you.